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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,098

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Yukio Yamaguchi

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EXAMINER

CHANG, LEONARD

ART UNIT

PAPER NUMBER

2812

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,098	Applicant(s) YAMAGUCHI, YUKIO	
	Examiner LEONARD CHANG	Art Unit 2812	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/244,074.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20100714</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The instant Office Action is in response to Applicant's Remarks filed with the Office on 9/15/2010.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 7/14/2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Oath/Declaration

3. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The newly added claims 16-25 are directed to a semiconductor device and based on the original claims are too narrow ("claiming less than I had right to claim"). However, the reissue application was filed *after* two-year limitation (i.e. after 6/27/2002) of the device patent U.S. PATENT No. 6,081,029. Thus, such error does not meet the "error" requirement under 35 USC 251 since the broaden claims were filed after two-year statutory limitation.

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

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The oath or declaration is defective because:
It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

Claim Rejections

5. **Claims 1-8 and 16-25** are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Note: This rejection based on a defective declaration was in the previous Office Actions of record. However, the Declaration was not corrected in response to the rejection(s).

6. **Claims 16-25** are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.

The instant reissue application was filed based on the U.S. Patent 6,455,348 (issued on 9/24/2002) by adding device claims 9-15 (now claims 16-25). However, U.S. Patent 6,455,348 claims are solely directed to methods of making a semiconductor device. U.S. Patent 6,455,348 was granted based on the application 09/521,670 which is a divisional application of 09/244,074. 09/244,074 matured into U.S. Patent 6,081,029 (issued 6/27/2000) which the claims are solely directed to a semiconductor device.

Therefore, the added claims 9-15 (or claims 16-25) in the instant reissue application should have been filed under the device patent U.S. Patent 6,081,029. Moreover, the added claim 16 is broader than the patent claims 4 or 6 in U.S. Patent

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6,081,029 by deleting “support lead is partially bent to function as a spring”. Thus, even if the reissue application was filed within two-years of U.S. Patent 6,455,348, the applicant may not present device claims that broaden the scope of the device patent U.S. Patent 6,081,029 after 6/27/2002 (two year date).

Thus, it appears that filing the instant reissue application based on the method patent U.S. Patent 6,455,348 instead of the device patent U.S. Patent 6,081,029, the applicant is circumventing two year statutory limitation for broadening claims of the original patent.

A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 U.S. PATENT Q2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 U.S. PATENT Q2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 U.S. PATENT Q 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 U.S. PATENT Q 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 U.S. PATENT Q 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 U.S. PATENT Q 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. **Claims 16-25** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 3, 6, 7, and 8 of U.S. Patent No. 6,081,029. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terminology "inner leads" is substantially the same as "signal-connecting leads" and "resin" normally is an "encapsulant".
2. **Claims 16 and 17** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26 and 27 of copending Application No. 12/179884. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terminology of "**recess**" is substantially the same as "**grooves**".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

If the same or similar claims are presented in more than one of the multiple reissue applications, the possibility of statutory double patenting (35 U.S.C. 101) or non-statutory (judicially created doctrine) double patenting should be considered by the examiner during examination, and the appropriate rejections made. A terminal disclaimer may be filed to overcome an obviousness type double patenting rejection. The terminal disclaimer is necessary in order to ensure common ownership of the

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reissue patents throughout the remainder of the unexpired term of the original patent.

MPEP § 1451.

Response to Arguments

7. *Re: Broadened claims outside the 2 yr statutory period*, is not found persuasive.

The fourth paragraph of 35 U.S.C. 251 states:

“No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.”

In the instant reissue application, the device patent U.S. Patent 6,081,029 ('029) was granted on July 27, 2000. Applicant did not file any reissue application within the two years from the grant of the device patent ('029). After two years from the grant of device patent, the applicant files a reissue application based on a method patent U.S. Patent 6,455,348 ('348) by adding device claims that are broader than the claims in the device patent ('029).

By electing the device claims in response to the restriction requirement made in the parent application '074 (now device patent '029), intent to pursue the invention directed to the device was made clear by the applicant. The intent of pursuing the invention directed to the device is further shown in that applicants filed a divisional application '670 (now method patent '348) based on the restriction requirement in the

parent application '074, the applicant elected to pursue the invention that is directed to the method.

Allowing device claims in the reissue application based on the method patent that are broader than the device patent after two years from the grant of the device patent clearly violates "balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights." *In re Graff*, 111 F.3rd 874, 42 USPQ2d 1471 (Fed. Cir. 1997).

There was no notice or intention that the applicant intended to broaden the device claims in the device patent '029 within the two years of grant of the device patent. The Board also stated that "Notice is critical since the potential expansion of the patentee's patent rights via reissue likewise affects the public's rights in an increased likelihood of infringing that expanded scope, notwithstanding the intervening rights provision of §252." *Ex parte Staats et al. (B.P.A.I. Appeal 2009-0071621 Application 11/503,541, Decided: April 26, 2010)*.

By allowing broader device claims in the reissue application that is based on the method patent will violate 35 USC 251, fourth paragraph, in circumventing the two-year statutory limitation.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD CHANG whose telephone number is (571)270-3691. The examiner can normally be reached on Mon-Thurs 9:00 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Garber can be reached on (571) 272-2194. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leonard Chang/
Examiner, Art Unit 2812

/Alexander G. Ghyka/
Primary Examiner, Art Unit 2812